

PATENT  
USSN 10/053,758  
Docket 002980US; 018/183c

#### REMARKS

As a result of the Preliminary Amendment filed September 21, 2004, the claims pending in this application are claims 1-17 and 20. The other claims were cancelled.

In this Response, only claim 13 has been amended to correct a typographical error in the sequence number.

A Restriction Requirement was imposed on the claimed invention on October 20, 2004.

#### Interview Summary:

The undersigned thanks Examiner Unger for the courtesy of a telephone interview on October 28, 2004. The Examiner confirmed that she now has access to the claim amendments and 37 CFR § 1.132 Declaration by Dr. Harley, and will examine the application in view of these submissions.

The undersigned undertook to respond to the Restriction Requirement insofar as it was relevant to the claims as amended.

#### Election of Group for Examination

The claims are subject to restriction between 9 groups:

- Group 1: Claims 1-8; product claims for antibodies and their equivalents specific for hTERT.
- Group 2: Claims 9-16 are method claims for the use of hTERT antibody to identify or detect hTERT or an hTERT peptide.
- Group 9: Claims 17 and 20 are method claims for producing hTERT specific antibody by immunizing with hTERT protein.

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Groups 3 to 8 of the restriction relate to the use of particular hTERT peptides for purposes of immunization. Since Claim 19 has now been cancelled, no reference is made to these peptides in the claims. The skilled reader will recognize from the description and general knowledge in the related art that hTERT antibodies can be made using the whole hTERT molecule or any fragment thereof which is immunogenic or rendered immunogenic in a suitable composition. hTERT antibodies can also be made by selecting antibody expressing cells or particles using antigenic fragments of hTERT, whether they are immunogenic or not.

Applicants hereby elect Group I for prosecution on the merits, without traversing the position taken in the Office Action that the groups are patentably distinct.

Reasons why the claimed invention should not be restricted

This application contains claims to all three categories indicated in 37 CFR § 1.141(b): product, a process of making the product, and a process for using the product. Applicants respectfully submit that 37 CFR § 1.141(b) bars the Office from imposing a restriction between the pending claims.

Furthermore, all the claims refer to SEQ. ID NO:225. Accordingly, the patentability of all the claims under 35 USC §§ 102 and 103 can be determined by searching SEQ. ID NO:225 and other public information about hTERT. MPEP § 803 indicates that a restriction requirement should only be imposed when examination of all the claims would impose a serious burden — regardless of whether the invention presented in each claim is patentably distinct. Since all the claims refer to SEQ. ID NO:225, no serious burden will be imposed if Groups 1, 2, and 9 are examined together.

Reconsideration and withdrawal of the restriction requirement is respectfully requested.

Request for Rejoinder:

In the event that the restriction is made final, applicants hereby request that the method claims be rejoined into the group under examination. Claims in the elected group refer to an antibody product specific for hTERT (SEQ. ID NO:225), and since the other claims are method claims referring to SEQ. ID NO:225 and the use of hTERT specific antibody. The method claims are therefore rejoinable into the elected group, upon determination that the product claims are patentable, as indicated in MPEP § 821.04

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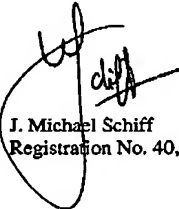
Conclusion

Applicant respectfully requests that the application proceed to examination on the merits, in view of the amendment and remarks made herein.

In the event the Examiner determines that an interview would facilitate prosecution of this application, he is invited to contact applicant's representative at the telephone number indicated below.

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,



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November 8, 2004

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*Facsimile Transmittal Sheet*

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